

REMARKS/ARGUMENTS

By this Amendment, claim 1 is amended. Claims 1-17 are pending.

Reconsideration of the July 1, 2003 Office Action is respectfully requested in view of the above amendment and the following remarks.

Claims 1-17 stand rejected under 35 U.S.C. § 103(a) over "applicants' acknowledged state of the art," or Japanese Publication Number 11-192671 ("JP 671"), in view of U.S. Patent No. 4,310,581 to Felter et al. ("Felter"). The rejection is respectfully traversed.

Claim 1, as amended, recites a laminated product comprising "a fiber reinforced resin layer ..."; "an elastic layer laminated on one surface of said fiber reinforced resin layer"; and "a surface protection layer laminated on the surface of said elastic layer for protecting the surface of said elastic layer, wherein *the surface protection layer is made of polyamide, polyester, or polypropylene*" (emphasis added). Support for the amendment to claim 1 is provided at page 21, lines 21-24, of the specification.

Applicants respectfully request entry of the amendment to claim 1, because the amendment (a) does not raise any new issue that would require further consideration and/or search; (b) does not raise the issue of new matter; (c) does not present additional claims without canceling a corresponding number of finally rejected claims; and (d) places the application in better form for appeal. In the Request for Reconsideration filed on June 18, 2003, Applicants explained that Felter does not suggest that its disclosed wear layer (of poly(vinyl chloride)) might be compatible with the JP 671 laminated product. Applicants

further explained that a surface protection layer according to the invention, such as a surface protection layer made of polyamide resin (as recited in claim 5), provides excellent properties (see page 6, third paragraph, of the specification). The amendment to claim 1 has been made to recite different surface protection layer materials, including polyamide, which has been previously considered during the prosecution of this application. Accordingly, Applicants respectfully submit that the amendment does not raise any new issue.

The cited references fail to suggest the laminated product recited in claim 1. JP 671 discloses a laminated product including a urethane-based resin layer and a fiber reinforced layer. The laminated product lacks a surface protection layer as recited in claim 1.

Felter discloses surface covering articles including a medium and fibers embedded in or "intimately associated" with the medium (column 3, lines 21-23). The articles can include an optional transparent wear layer, which may be a poly(vinyl chloride) layer (column 3, lines 54-58, and EXAMPLE 1 at column 4, line 51 - column 5, line 13). Felter does not suggest applying the wear layer on a urethane resin layer as disclosed in JP 671. However, the Office Action asserts that "the broad [sic] teaching in Felter of applying his covering layer to *any resilient or rubber flooring layer* would suggest application of the covering layer to *any resilient flooring layer*, such as a urethane flooring laminate as disclosed in the primary references." Applicants respectfully submit that Felter does not disclose or suggest the covering layer to any resilient or rubber flooring layer. In fact, Felter does not suggest that the poly(vinyl chloride) covering layer could be applied to

any material other than the vinyl chloride plastisol-containing material used in EXAMPLE

1. The Office Action further asserts that "Felter does not limit his cover layer to PVC and it is well within the purview of one of ordinary skill in the art [to] select *any well known material* for the cover layer that is compatible with the layer to which it is to be laminated" (emphasis added). However, Felter does not suggest that the wear layer could be made of any well known material; the Office Action provides no basis for this assertion.

Felter fails to disclose or suggest a surface protection layer made of polyamide, polyester, or polypropylene, as recited in claim 1. Thus, even if the JP 671 laminated product were modified to include Felter's poly(vinyl chloride) surface covering layer, this modification would not result in the laminated product recited in claim 1. Therefore, because the combination of JP 671 and Felter fails to disclose or suggest all of the features recited in claim 1, the laminated product recited in claim 1 would not have been *prima facie* obvious for at least this reason. *See*, MPEP §§ 2143 and 2143.03.

Even though the Office Action failed to establish a *prima facie* case of obviousness, Applicants have provided a Declaration Under 37 C.F.R. § 1.132 ("Declaration") by Tamio Kawasumi, one of the co-inventors of the claimed invention, which rebuts the alleged *prima facie* case of obviousness. As described in the Declaration, Examples of a laminated product according to the claimed invention, as well as Comparative Examples, were produced and tested to determine their stain resistance, chemical resistance, abrasion resistance, and caster resistance. The test results produced demonstrate superior and unexpected results that can be provided by the claimed laminated product.

Applicants respectfully submit that the Declaration also does not raise any new issue that would require further search and/or consideration. Namely, the Declaration provides experimental evidence for the purpose of rebutting the assertion in the Office Action that "Felter does not limit his cover layer to PVC and it is well within the purview of one of ordinary skill in the art [to] select *any well known material* for the cover layer that is compatible with the layer to which it is to be laminated" (emphasis added). The experimental evidence demonstrates that the laminated product according to the claimed invention provides superior results as compared to the known material disclosed by Felter and, accordingly, does not raise any new issue.

As described at page 2 of the Declaration, in Example 1-1, a laminated product was fabricated including a polyamide film laminated on an elastic layer (made of polyurethane) in accordance with claim 1. In Comparative Example 1-1, a laminated product was fabricated by the same method used in Example 1-1, but a release coated paper was laminated on the elastic layer instead of a polyamide film. In Comparative Example 1-2, a laminated product was fabricated by the method used in Example 1-1, but a plasticized poly(vinyl chloride) film as disclosed in Felter was laminated on the elastic layer instead of a polyamide film.

As explained at pages 2-3 of the Declaration, in Experiment 1, the Example 1-1 and Comparative Example 1-1 and 1-2 laminated products were tested for stain resistance using a heel mark test based on the standard JIS K 3920-16. The Example 1-1 laminated product

according to the claimed invention provided superior stain resistance as compared to the Comparative Example 1-1 and 1-2 laminated products.

As explained at pages 3-4 of the Declaration, in Experiment 2, Example 2-1 and Comparative Example 2-1 and 2-2 laminated products were fabricated by the same methods used to fabricate the Example 1-1 and Comparative Example 1-1 and 1-2 laminated products, respectively. The Example 2-1 and Comparative Example 2-1 laminated products were tested for chemical resistance using a test based on the standard JIS A1415, using phosphoric acid, hypochlorous acid, and toluene as chemicals in the test.

The Example 2-1 laminated product according to the claimed invention displayed no visible change after exposure to the different chemicals. However, the Comparative Example 2-1 laminated product displayed visible change for each of the three chemicals. There was insufficient time to provide results for the Comparative Example 2-2 laminated product.

As explained at page 4 of the Declaration, in Experiment 3, Example 3-1 and Comparative Example 3-1 and 3-2 laminated products were fabricated by the same methods used to fabricate the Example 1-1 and Comparative Example 1-1 and 1-2 laminated products, respectively. The Example 3-1 and Comparative Example 3-1 and 3-2 laminated products were tested for abrasion resistance using a test based on the standard JIS K7204 Taber Abrasion Test, which is a typical test method to evaluate the abrasion durability of a flooring material (*see*, page 22, line 10-12, of the specification).

As described at page 4 of the Declaration, the Example 3-1 laminated product according to the claimed invention had a significantly lower abrasion loss than the Comparative Example 3-1 and 3-2 laminated products. Particularly, the abrasion losses were: Example 3-1, 34 mg; Comparative Example 3-1, 46 mg; an Comparative Example 3-2 including a plasticized poly(vinyl chloride) surface film; 118 mg.

As explained at page 5 of the Declaration, in Experiment 4, Example 4-1 and Comparative Example 4-1 and 4-2 laminated products were fabricated by the same methods used to fabricate the Example 1-1 and Comparative Example 1-1 and 1-2 laminated products, respectively. The Example 4-1 and Comparative Example 4-1 and 4-2 laminated products were tested for caster resistance using a test based on the standard JIS A1514 caster test A.

As described at page 5 of the Declaration, the Example 4-1 laminated product according to the claimed invention wore at 1500 rotations. In stark contrast, the Comparative Example 4-2 laminated product displayed peeling of the plasticized poly(vinyl chloride) film from the polyurethane layer at only 50 rotations. The Comparative Example 4-1 laminated product displayed peeling of the polyurethane layer at 2500 rotations, but was considered after the surface protection layer (film) was peeled or broken. Accordingly, this example cannot be directly compared with the Example 4-1 laminated product according to the claimed invention.

The test results described in the Declaration demonstrate superior, unexpected results, including excellent stain resistance, chemical resistance, abrasion resistance, and

caster resistance, that can be provided by the claimed laminated product. These unexpected results are sufficient to rebut any alleged *prima facie* case of obviousness. Accordingly, it is respectfully submitted that the laminated product recited in claim 1 is patentable over the cited references. Dependent claims 2-17 are also patentable for at least the same reasons that claim 1 is patentable.

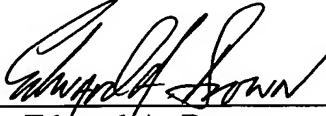
Therefore, withdrawal of the rejection is respectfully requested.

For the foregoing reasons, Applicants respectfully request allowance of this application.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

Date: September 30, 2003

By: 
Edward A. Brown
Registration No. 35,033

P.O. Box 1404
Alexandria, Virginia 22313-1404
(703) 836-6620